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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,402	01/04/2007	Gursharan Singh Chana	P01466-US-00 (13030.0010)	6188
23446	7590	10/27/2010	EXAMINER	
ICE MILLER LLP				
ONE AMERICAN SQUARE, SUITE 3100				
INDIANAPOLIS, IN 46282-0200				
			ART UNIT	PAPER NUMBER
			3775	
			MAIL DATE	DELIVERY MODE
			10/27/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/596,402

Applicant(s)

CHANA, GURSHARAN SINGH

Examiner

SAMEH BOLES

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any named patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13, 17-20 and 27-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-16 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/12/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

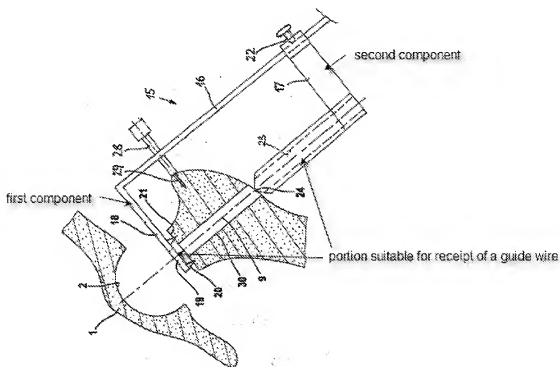
Applicant's election with traverse of Group I, claims 1-43 drawn to a targeting device; and species 1: Fig. 1a in the reply filed on September 15, 2010 is acknowledged.

The traversal is on the ground(s) that the prior art of Chung et al (WO 01/91648) fails to show that the groups and species of inventions lack the same or corresponding special technical features, wherein Chung does not teach the claimed invention as for claim 1 such as "first and second components spaced apart from and parallel to one another where means are provided to alter the distance between the first and second components and means is provided to maintain the first and second components in a predetermined position relative to each other and wherein one or both of the first component and the second component has a portion suitable for receipt of a guide wire." In particular, the parallel parts 17 and 18 of Chung, which have been indicated in the Office Action to be the first and second components, cannot receive a guidewire.

This is not found persuasive because Chung teaches a targeting device (see modified Fig. 2 below) comprises first (18) and second (17) components spaced apart from and parallel to one another where means (16) are provided to alter the distance between the first and second components and means (22) is provided to maintain the first and second components in a predetermined position relative to each other and wherein one or both of the first component (18) and the second component (17) has a passage portion (19 and 23 respectively) suitable for receipt of a guide wire. Therefore,

the prior art of Chung proves that the groups and species of inventions lack the same or corresponding special technical features, and the targeting device is not considered to be a "special technical feature" due to the fact that it is not novel.

The requirement is still deemed proper and is therefore made FINAL.



Claims 12-13, 20 and 27-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II and species 2-4.

Claims 17-19 teach "first and second components is provided with a mounting portion", therefore claims 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species 3. There being no allowable generic or linking claim. Claims 1-11, 14-16, 21-26 are examined in this office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 23 recites the limitation " the elongate support " in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 8, 10-11, 14, 16 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Snyder (US. Pat. No. 6129729).

Snyder teaches a targeting device (Fig. 45a) comprises at least a first component (575, Fig. 46a) having a portion suitable for location on an outer surface of the femoral neck and a second component (546, Fig. 46a) having a portion (545, Fig. 42) suitable for marking the centreline of the femoral neck, wherein the first and second components are spaced apart from and parallel to one another (Fig. 45a) and means (springs 568, Fig. 46a) is provided to alter the distance between the first and second components (figs. 46a-46d) and means (locking rim 572 and lock-release lever 554, Fig. 45b) is provided to maintain the first and second components in a predetermined position relative to each other (Fig. 46d) and wherein one or both of the first component and the second component has a portion (564, Figs. 43 and 45b) suitable for receipt of a vertical

alignment rods (146, Fig. 22) which can be considered as a guide wire; wherein the first component has a portion suitable for receipt of a first guide wire and the second component has a portion suitable for receipt of a second guide wire. the first and second components are identical in configuration (Fig. 42), wherein each of the first and second components includes an elongate three dimensional shape (Fig. 4) for location on an outer surface of the femoral neck or for marking the centreline of the femoral neck. a central bore (545, Fig. 42) is provided along the centre of each of the elongate three dimensional shapes of the first and second components (Fig. 43). the first component (575) is provided with one or more runners (570, Fig. 43), the or each runner is elongate and extends such that its longitudinal axis is perpendicular to that of the first component., wherein the second component is provided with means (542a, Fig. 42) to movably engage the or each runner (Fig. 45b); wherein where there are two or more runners and the runners are parallel to each other; wherein one or more springs (568, Fig. 45b) is provided between the first and second components to assist movement of the second component away from the first component. the longitudinal axes of the or each runner (570) parallel to the longitudinal axis of the elongate support (546) and the longitudinal axes of the first and second components each lie perpendicular to these axes and are spaced apart from and parallel to each other (Fig. 42); wherein the first component (575) is mounted on an elongate support (546); wherein the elongate support has a handle portion (594, Fig. 44a) distal from the first component (Fig. 41).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6-7, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder.

Snyder fails to teach that each three dimensional shape of the first and second components is 2 to 8 cm in length; the central bore has a diameter of 1.5 to 5 mm; each runner is up to 6 cm in length; and the elongate three dimensional shape is a cylinder.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct each three dimensional shape of the first and second components is 2 to 8 cm in length; the central bore has a diameter of 1.5 to 5 mm; each runner is up to 6 cm in length, since it has been held that discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Also, it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to modify the elongate three dimensional shape with a cylinder shape, since applicant has not disclosed that such provides an advantage, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the shape of Snyder's device, and the shape of applicant's device, to perform equally well and to perform the same function of locating the device on the outer surface of bone and for marking the centerline of the bone, a person ordinary skill

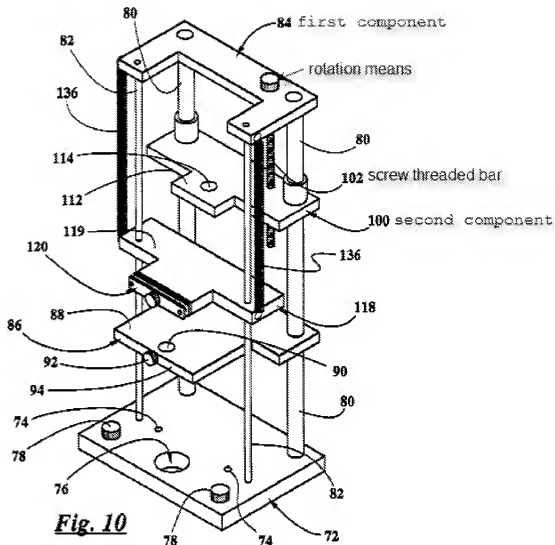
in the art would find obvious for the purpose of providing an effective targeting device. In re Dailey and Eilers, 149 USPQ 47 (1966).

7. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of Real (US. Pat. No. 5817106).

Snyder fails to teach that the means provided to alter the distance between the first and second components comprises provision of a screw threaded bar received by corresponding screw threaded portions on each of the first and second components, and the screw threaded bar is provided with a suitable means to cause its rotation.

Real teaches a targeting device (Fig. 10) comprises of first component (84) and a second component (100), means provided to alter the distance between the first and second components comprises provision of a screw threaded bar (102) received by corresponding screw threaded portions on each of the first and second components (Fig. 10) (col. 7, lines 43-48), and the screw threaded bar is provided with a suitable means (see modified Fig. 10 below) to cause its rotation.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the means provided to alter the distance between the first and second components of Snyder with a screw threaded bar in view of Real for providing an effective mechanism for facilitating controlling the distance between the first and second components.



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMEH BOLES whose telephone number is (571)270-5537. The examiner can normally be reached on Monday - Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMEH BOLES/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775